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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,762	01/21/2000	Tetsuo Watanabe	3190-004	4870

7590 12/02/2003

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EXAMINER	
MULCAHY, PETER D	
ART UNIT	PAPER NUMBER
1713	19

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/488,762	WATANABE ET AL.	
	Examiner	Art Unit	
	Peter D. Mulcahy	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 September 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 02-001284, Haffner et al. or Wehner et al.

The rejections as set forth under 35 U.S.C. § 103 on pages 3 and 4 of Paper No. 17 are deemed proper and are herein repeated.

Applicants' newly amended claims as well as the remarks filed in support thereof have been fully considered but have been found to be not persuasive.

With respect to the Japanese patent document, applicants argue that this teaching relates to an externally applicable aid which is intended to be applied to an injury. Applicants argue that there is n o teaching or suggestion of a stress relaxation ratio as is recited in claim 6 and there is no evidence as to why such a property would be inherent from this reference. This is not persuasive. Each of applicants' claimed compositional ingredients is shown and suggested to one of ordinary skill in

the art that they be used in combination with one another within the ratios as claimed. Given that the prior art teaches articles which can be formed from the composition as claimed, it is reasonable to presume that these compositions can possess properties which either render obvious or anticipate those as claimed. Applicants have failed to show or allege that the articles as taught in the prior art do not possess properties which either render obvious or anticipate those as claimed. Applicants' arguments with respect to the ratios as set forth in claim 5 are found not persuasive. These claimed ratios can be found in the translation provided by applicants at page 6.

Applicants argue that the Haffner patent fails to discuss the stress relaxation properties of the tape. This is not persuasive. Once again the Haffner patent teaches articles which are formulated from the compositional ingredients as claimed. As such it is reasonable to presume that the articles which are formulated from the compositions inherently possess properties which either render obvious or anticipate those as claimed. Applicants have failed to show or allege that such is not the case.

Applicants argue that the Wehner patent is different from the instantly claimed article and that the adhesive as used in the prior art is intended to mean a substance which is capable of

bonding other substances together by surface attachment. Applicants argue that Wehner does not teach or suggest the adhesive being attachable to a skin surface. This is not persuasive. This claim language is seen to be a mental step which does not further limit the claim. Furthermore one of ordinary skill in the art would readily appreciate that the adhesive which is intended to be attached to another surface would certainly be attachable to skin. Applicants have not shown or alleged that such is not the case.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) The invention was described in (1) an application for patent, published under Section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kobylivker.

The rejection as set forth under 35 U.S.C. § 102/103 in Paper No. 14 is deemed proper and is herein repeated.

Applicants' newly amended claims as well as the remarks filed in support thereof have been fully considered but have been deemed to be not persuasive.

Applicants argue that the medical apparel identified by Kobylivker et al. does not suggest a medical adhesive tape or sheet which is applied directly to the skin. This is not persuasive. The Examiner would point out that applicants' claim language is "for attaching" and "is attachable." This language is open to a gown which either ties or is hung over the shoulders or is even tied to a person or skin surface. This language does not limit the article to an adhesive tape which is adhered to the skin surface as applicants are apparently interpreting this language. The Examiner continues to maintain that the articles as shown in Kobylivker read on a "medical sheet" which is seen to be within the claim language.

Claim 1 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Applicants' claim as amended has redundant claim language. This is to say that the language "parts by weight of a

thermoplastic resin and 10 to 200" is recited twice. Applicants have failed to underline this as being language added and as such it would appear to be a typographical error. Clarification is required.

Claim 1 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

The claim language "for attaching onto a skin surface" and "is attachable to a skin surface" is seen to be new matter. It is unclear as to exactly where in the specification the breadth of the term "attaching" is supported. Applicants have identified specific portions of the specification for support, however these portions do not identify or describe the "attached" limitation as recited in the claims.

Applicants' amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a

final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter D. Mulcahy, whose telephone number is (703) 308-2449. The examiner can normally be reached on Tuesday through Friday from 7:30 A.M. to 6:00 P.M.

The fax telephone number for this group is (703) 872-9306.

Any inquiry of general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2351.

P. Mulcahy:cdc
December 1, 2003

PETER D. MULCAHY
PRIMARY EXAMINER